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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78514746
Applicant	HONDA MOTOR CO., LTD.
Applied for Mark	RL
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Submission	Applicant's Motion to Suspend
Attachments	10691-122pp2-Appli. Motion for suspension.pdf (7 pages)(223348 bytes)
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Signature	/ALF mva/
Date	11/19/2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Application Serial No.: **78/514,746**

Trademark: **RL**

Applicant: **HONDA MOTOR CO., LTD.**

APPLICANT'S MOTION FOR SUSPENSION

Pursuant to Section 1213(1) of the Trademark Trial And Appeal Board Manual of Procedure, TBMP § 1213(1) Applicant hereby requests suspension of the *ex parte* appeal in the above-entitled Application pending final determination of the cancellation served and filed November 16, 2007, a copy of the Petition for which (minus exhibits) is annexed as Exhibit A hereto. The pending *ex parte* appeal challenges the Examiner's citation of Registration No. 2,912,328 as a barrier to registration of the mark sought to be registered in the present application. If the cancellation action is successful, or is settled on favorable terms to Petitioner, the present *ex parte* appeal will become moot, because there will be no need to resolve the question appealed herein.

Dated: November 19, 2007

Respectfully submitted,

FISH & RICHARDSON P.C.

By: 

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Attorneys for Applicant Honda Motor Co., Ltd.

Exhibit A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 2,912,328

For the Mark **RL-CLASS**

Issued on December 21, 2004

HONDA MOTOR CO., LTD.,

Petitioner,

v.

DAIMLERCHRYSLER AG,

Respondent.

Cancellation No.

PETITION FOR CANCELLATION

Honda Motor Co., Ltd., a corporation duly organized and existing under the laws of Japan, and having an address of 1-1, 2-Chome, Minami-Aoyama, Minato-Ku, Tokyo, 107-8556, Japan, believes that it is and will be damaged by the continued registration of the mark **RL-CLASS** shown in the above-identified registration, and hereby petitions to cancel the same.

As grounds therefore, it is alleged that:

1. Honda Motor Co., Ltd., itself and through subsidiaries, affiliates and related companies (collectively, "Petitioner"), manufactures, markets and sells, among other products,

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Date of Deposit

NOVEMBER 16, 2007

Signature

Anthony L. Fletcher

Typed or Printed Name of Person Signing Certificate

automotive vehicles, including passenger automobiles, sport utility vehicle trucks ("SUVs"), pickup trucks, minivans, motorcycles and all terrain vehicles ("ATVs") throughout the world.

2. Petitioner uses and has used, since at least as early as December 31, 1995, and long prior to February 28, 2003, the mark **3.5RL** for its automobiles and structural parts thereof.

3. Petitioner owns U.S. Registration No. 2,281,336, issued September 28, 1999, for the mark **3.5RL** for automobiles and structural parts thereof in International Class 12. A copy of Petitioner's Certificate of Registration for U.S. Registration No. 2,281,336 is annexed hereto as Exhibit A.

4. U.S. Registration No. 2,281,336 is valid, subsisting and uncanceled. A copy of Petitioner's Notice of Acceptance under Section 8 of the Federal Trademark Act, 15 U.S.C. §1058, and Petitioner's Notice of Acknowledgment under Section 15 of the Federal Trademark Act, 15 U.S.C. §1065, for U.S. Registration No. 2,281,336 is annexed hereto as Exhibit B.

5. Within the unitary mark **3.5RL**, "3.5" is merely descriptive of a characteristic of the engine, while "RL" is arbitrary. Petitioner owns valuable goodwill in its **3.5RL** mark, the primary and dominant element of which is "RL".

6. Respondent, DaimlerChrysler AG ("Respondent"), filed U.S. Application Serial No. 76/539,718 on August 25, 2003 for the mark **RL-CLASS** for automobiles and their structural parts in International Class 12, toy automobiles among other toys and sporting goods in International Class 28, and repair and maintenance of motor vehicles in International Class 37. Respondent based this application on an intent to use the mark in U.S. commerce. Respondent also claimed a priority filing date of February 28, 2003, under Section 44(d) of the Federal Trademark Act, 15 U.S.C. §1126(d), based on its application to register the mark **RL-CLASS** in Germany, which it filed on February 28, 2003. Respondent's U.S. Application Serial No.

76/539,718 issued to registration on December 21, 2004 under U.S. Registration No. 2,912,328, a copy of which is annexed hereto as Exhibit C.

7. Within the unitary mark **RL-CLASS**, “RL” is arbitrary, while “-CLASS” is either descriptive or generic.

8. Respondent’s **RL-CLASS** mark for automobiles and their structural parts so closely resembles Petitioner’s previously used and registered **3.5RL** mark that, when applied to Respondent’s automobiles and their structural parts, it is likely to suggest a false connection or association with Petitioner in violation of Section 2(a) of the Federal Trademark Act, 15 U.S.C. §1052(a), and is likely to cause confusion, to cause mistake and to deceive, with resulting injury to Petitioner, in violation of Section 2(d) of the Federal Trademark Act, 15 U.S.C. §1052(d).

9. Petitioner uses and/or has used the mark **RL** (without “3.5”) for its automobiles and the structural parts thereof since at least as early as October 31, 2004.

10. Petitioner filed U.S. Application Serial No. 78/514,746 on November 10, 2004 for the mark **RL** for automobiles and structural parts thereof in International Class 12. A copy of Petitioner’s Application Serial No. 78/514,746 is annexed hereto as Exhibit D.

11. The U.S. Patent and Trademark Examiner assigned to U.S. Application Serial No. 78/514,746 has refused to register the mark, alleging that the mark in U.S. Application Serial No. 78/514,746 so closely resembles the mark in Respondent’s U.S. Registration No. 2,912,328 as to be likely to cause confusion, or to cause mistake or to deceive. A copy of the Examiner’s final refusal to register U.S. Application Serial No. 78/514,746 is annexed hereto as Exhibit E.

12. Based upon the foregoing, the registration of the mark depicted in U.S. Registration No. 2,912,328, registered on December 21, 2004 on the Principal Register of the

United States Patent and Trademark Office, has and/or will cause injury and damage to
Petitioner.

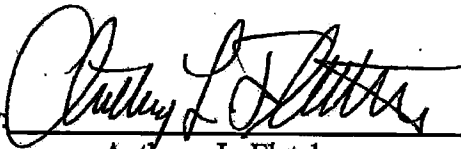
WHEREFORE, Petitioner requests that U.S. Registration No. 2,912,328 for **RL-
CLASS** owned by Respondent be cancelled, and that this Petition for Cancellation be sustained
in favor of Petitioner.

Please charge Deposit Account 06-1050, Order No. 10691-0122002, for the filing fee for
this Petition for Cancellation, as well as for any other fees that may be due.

Dated: November 16, 2007

Respectfully submitted,

FISH & RICHARDSON P.C.

By 

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Attorneys for Petitioner,

HONDA MOTOR CO., LTD.

CERTIFICATE OF SERVICE

I hereby certify that I have this 16th day of November, 2007 served one copy of the foregoing Petition to Cancel Registration No. 2,912,328 upon Registrant by mailing one copy of the same, first class postage prepaid, to Registrant's Agent for Service of record,

V. T. GIORDANO, ESQ.

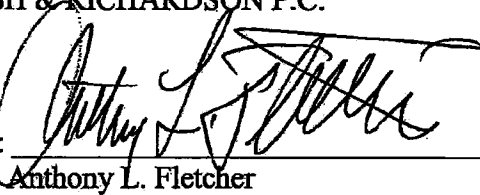
VON MALTITZ, DERENBERG, KUNIN, JANSSEN

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